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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,836	11/08/2006	Lars Ole Lyngso	05432/1200888-US1	6949
7278	7590	12/10/2008	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			GALLIS, DAVID E	
			ART UNIT	PAPER NUMBER
			1625	
			MAIL DATE	DELIVERY MODE
			12/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/597,836	LYNGSO, LARS OLE	
	Examiner	Art Unit	
	DAVID E. GALLIS	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 13-25, 31-34, 38, 39, 41 and 42 is/are allowed.
- 6) ☒ Claim(s) 10, 11, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 12, 28-30, 35-37 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/30/08</u> . | 6) <input type="checkbox"/> Other: _____ |

/ Bernard Dentz/

DETAILED ACTION

1. Claims 1 through 42 are pending. Claims 1 has been amended. Claims 41 and 42 have been newly added. Applicant's claim to priority from provisional application 60/544970 filed February 12, 2004 is acknowledged. Applicant's amendments and arguments filed August 22, 2008 have been entered and carefully considered.

Prior Rejections

2. With regard to the prior rejection of claims 1 and 16 through 21 under the first paragraph of 35 U.S.C. 112 on the basis of lacking enablement for all cyclic anhydrides and imides, Applicant has argued that each recited cyclic anhydride and imide possesses functional groups suitable for acylation of a formula (II) compound, and it is not necessary to provide information regarding the product solubilities in suitable solvents. Applicant's argument is found to be persuasive. Therefore, the rejection of claim 1 and 16 through 21 as lacking enablement for all recited cyclic anhydrides and imides is hereby withdrawn.

3. With regard to the prior rejection of claims 1, 13, 15 and 23 through 27 under the first paragraph of 35 U.S.C. 112 on the basis of lacking enablement for R, R¹, Y and Z substituents, Applicant has amended claim 1 to excluded hydroxyl and amino R¹, and to clearly specify the groups that may be converted to cyano and dimethylaminomethyl moieties. Claims 26 and 27, however, contain R¹ as hydroxyl and amino which have been removed from claim 1. Therefore, the rejection of claim 1, 13, 15 and 23 through 25 as lacking enablement for R, R¹, Y and Z substituents is hereby withdrawn, however,

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claims 26 and 27 are rejected as lacking enablement for R, R¹, Y and Z substituents for reasons of record.

4. With regard to the prior rejection of claims 10 and 11 under the first paragraph of 35 U.S.C. 112, Applicant argues that the order in which conversions are made to the R, Z, and Hal groups is inconsequential. The argument by Applicant is found, however, not to be persuasive. As stated in the instant specification, a cyano group can be converted to a dimethylaminomethyl group. This clearly would restrict the order in which the Z and R groups can be respectively converted to dimethylaminomethyl and cyano. In the instance where Z and R are both cyano, conversion of Z to dimethylaminomethyl would also alter R as cyano. Therefore, the rejection of claims 10 and 11 as lacking enablement is hereby maintained for reasons of record.

Claim Objections

5. Claims 12, 28 through 30, 35 through 37, and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Gallis whose telephone number is 571-272-9068. The examiner can normally be reached on Mon-Thur 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-1600. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David E. Gallis
Patent Examiner

/ Bernard Dentz/

Primary Examiner, Art Unit 1625